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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/856,403 | 07/27/2001 | Gerold Tebbe | 011105 | 9180 |
| 22876 | 7590 | 01/25/2005 | EXAMINER | |
| FACTOR & LAKE, LTD 1327 W. WASHINGTON BLVD. SUITE 5G/H CHICAGO, IL 60607 | | | LEWIS, KIM M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3743 | |

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,403

Applicant(s)

TEBBE, GEROLD

Examiner

Kim M. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-11 and 13-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-11,14-27,29-42,44-56 and 58-62 is/are rejected.
- 7) ☒ Claim(s) 13,28,43 and 57 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Action.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application prior to the close of prosecution. As such, the request is improper. The applicant should note that since prosecution was not closed on this application, the amendment filed 10/12/04 has been entered.

Summary

2. Claims 1, 18, 19, 33, 34, 48, 49 and 62 have been amended. Claims 2, 3, 10, 12, 26, 41 and 55 have been canceled. Claims 1, 2-9, 13-25, 27-40, 42-54 and 56-62 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 94/15561 ("Newman") in view of U.S. Patent No. 4,202,925 ("Dabroski").

As regards claim 1, Newman substantially discloses applicant's claimed invention. More specifically, Newman discloses an invisible bandage assembly (plaster) comprising a base layer and adhesive layer (adhesive tape 12), a working layer (page 6, lines 12-27), whereby an external surface of the base layer remote from the adhesive layer is formed in such a way that it accepts a cosmetic preparation, and wherein further the external surface of the base layer is rough (textured) (page 2, lines 11-15, page 4, lines 10-14 and page 5, lines 9-25).

Newman discloses that the tape has a texture that retains the cosmetic cover (*i.e.*, it is either lipophilic or hydrophilic), but fails to explicitly state that the texture is from a surface treatment. However, it would have been *prima facie* obvious to one having ordinary skill in the art to provide the texture on the paper tape via a surface treatment such as embossing or molding a texture on the surface of the tape.

Newman also fails to teach that the base layer has thickness of between 20 micrometers to 100 micrometers. Dabroski, however, discloses that it is conventionally known to provide paper tape having a thickness of 2 to 21 mils (col. 2, lines 13-45) as an obvious design choice. The claimed range of between 20 micrometers (.7 mils) to 100 micrometers (3.9 mils) falls within the claimed range of Dabroski.

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It would have been obvious to one having ordinary skill in the art to manufacture the paper tape of Newman with a thickness of 2 to 21 mils since Dabroski teaches it is conventionally known to do so. And, given the environment in which the paper tape is used (*i.e.*, to hold a cosmetic composition so as to hide a scar), one having ordinary skill in the art would have been motivated to make the bandage as thin as possible, within the claimed range of 20 micrometers (.7 mils) to 100 micrometers (3.9 mils) in order to make the tape less conspicuous.

As regards claim 18, Newman fails to teach the backing layer has a thickness between 30 micrometers and 60 micrometers. Again, one having ordinary skill in the art would have been motivated to make the bandage as thin as possible, within the claimed range in order to make the tape less conspicuous.

6. Claims 4, 15, 19, 30 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Dabroski as applied to claim 1 above, and further in view of U.S. Patent No. 5,120,325 ("Dow, Jr.").

As regards claim 4, both Newman and Dabroski fail to teach the external surface of the paper tape exhibits an imprint with a skin pattern. Dow, Jr., however, discloses a bandage having a base layer (backing layer) that has a rough surface in the form of folds and grooves to simulate the texture of human skin (col. 1, lines 44-49 and col. 2, lines 40-44),

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In view of Dow, Jr., it would have been obvious to provide the modified tape layer of Newman with folds and grooves (*i.e.*, to provide the tape layer with an imprint with a skin pattern) to simulate the texture of human skin.

As regards claims 15 and 30, it is inherent in the disclosure of Newman that the adhesive is constantly tacky. Dow, Jr. discloses at col. 2, lines 63-66 that a peelable protective layer can be applied to the adhesive layer to prevent premature adhesion of the bandage. This protective layer reads on the backing layer of the present invention. It would have been obvious to one having ordinary skill in the art to provide the modified bandage of Newman with a protective layer in order to prevent premature adhesion of the bandage.

As regards claims 19 and 20, note the rejection of claims 1 and 4 above.

As regards claim 33, note the rejection of claims 18 and 19 above.

7. Claims 5, 6, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view Dabroski as applied to claim 1 above, and further in view of U.S. Patent No. 3,797,494 ("Zaffaroni").

As regards claims 5 and 6, the modified device of Newman fails to teach that the absorbent layer (working layer) comprises at least one microencapsulated active substance. However, Zaffaroni discloses a bandage comprising a working layer (12) having uniformly distributed therein, microcapsules (13) comprising a drug (*e.g.*, pharmaceuticals acting on the skin such as bacitracin and hydrocodisone) encapsulated

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with a microporous rate controlling material for the continuous administration of drugs to the skin or mucosa (abstract and col. 9, lines 54-66).

In view of Zaffaroni, it would have been obvious to one having ordinary skill in the art to modify the absorbent pad (working layer) of Newman with the addition of microcapsules comprising a drug (e.g., encapsulated with a microporous rate controlling material for the continuous administration of drugs to the skin or mucosa.

As regards claims 16 and 17, the modified device of Newman fails to teach drying agents in the form of kieselguhr and aluminum oxide, and skin care products in the form of soothing oils. Absent a critical teaching and/or a showing of unexpected results derived from providing the working layer with drying agents in the form of kieselguhr and aluminum oxide, and skin care products in the form of soothing oils, the examiner contends that the addition of any active substance to the modified bandage of Newman is an obvious design choice, which does not patentably distinguish applicant's invention.

8. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman and Dabroski as applied to claim 1 above, and further in view of U.S. Patent No. 2,905,174 ("Smith").

As regards claim 7, the modified device of Newman fails to teach a printing-ink layer. However, Smith teaches an adhesive bandage with a transparent film backing, in which the backing is provided with a series of cosmetic preparations in the form of flesh-

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colored markings (printing-ink layer) (col. 1, line 65-col. 2, line 29 and col. 4, lines 51-56) for the purpose of rendering the bandage less noticeable.

It would have been obvious to additionally provide the modified device of Newman with the flesh- colored marking (printing-ink layer) as taught by Smith, in order to further conceal an/or render the bandage less noticeable.

As regards claim 8, Smith discloses that the printing-ink layer is between the transparent backing and the adhesive layer (col. 4, lines 57-60). When the bandage of Newman is modified to contain the printing ink layer, it too will have the printing-ink layer is between a transparent backing and the adhesive layer. Additionally, since Newman fails to teach a transparent backing one having ordinary skill in the art would be motivated to construct the backing layer from transparent material, as taught by Smith, in order to allow the bandage to blend into the skin.

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newman and Dabroski as applied to claim 1 above, and further in view of U.S. Patent No. 4,702,237 ("Gianopoulos et al.").

As regards claim 9, the modified device of Newman fails to teach the backing layer is constructed from rubber. Gianopoulos et al. teach it is conventional to construct bandages with latex rubber backing layers because latex rubber is flexible yet strong and does not irritate the skin.

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In view of Gianopoulos et al., it would have been obvious to one having ordinary skill in the art to construct the modified bandage of Newman with a latex rubber backing because latex rubber is flexible yet strong and does not irritate the skin.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Dabroski as applied to claim 1 above, and further in view of U.S. Patent No. 4,618,519 ("Koch et al.").

As regards claim 11, the modified device of Newman fails to teach a curable adhesive. However, Koch et al. teach it is conventional to provide adhesive articles with a curable adhesive that cures at ambient temperature such that the article can cure *in situ* (abstract).

In view of Koch et al., it would have been obvious to one having ordinary skill in the art to modify the modified device of Newman by substituting the disclosed adhesive for a curable adhesive so that the bandage can cure *in situ*. This will allow proper placement of the article without premature adhesion of the article to an unwanted area on the skin.

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Dabroski as applied to claim 1 above, and further in view of U.S. Patent No. 4,807,753 ("Goldstein").

Regarding claim 14, the modified device of Newman substantially discloses all features of the claim except a set comprising a plurality of bandages of various sizes.

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However, Goldstein teaches it is conventional in the art to provide a set comprising a plurality of bandages in order to fit various sized wounds. In view of Goldstein, it would have been obvious to one having ordinary skill in the art provide the modified bandages of Newman in a set comprising various sizes in order to fit various sized wounds.

As to the bandage being punched out of a planar material, the applicant should note that in a product claim, the method by which the product is formed is a non-distinctive characteristic, which does not serve to distinguish.

12. Claims 21, 22, 21 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Dabroski and Dow, Jr. as applied to claim 19 above, and further in view of Zaffaroni.

As regards claims 21 and 22, note the rejection of claims 5, 6 and 19 above.

As regards claims 31 and 32, note the rejection of claims 22 above.

13. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Dabroski and Dow, Jr. as applied to claim 19 above, and further in view of Smith.

As regards claims 23 and 24, note the rejection of claims 7, 8 and 19 above.

14. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Dabroski and Dow, Jr. as applied to claim 19 above, and further in view of Gianpoulos et al.

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As regards claim 25, note the rejection of claim 9 and 19 above.

15. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Dabroski and Dow, Jr. as applied to claim 19 above, and further in view of Koch et al.

As regards claim 27, note the rejection of claims 11 and 19 above.

16. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Dabroski and Dow, Jr. as applied to claim 19 above, and further in view of Goldstein.

As regards claims 29, note the rejection of claims 14 and 19 above.

17. Claims 34, 36, 39, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Dabroski and Smith.

As regards claim 34 and 36, note the rejection of claims 1 and 7 above.

As regards claim 39, note the rejection of claims 8 and 34 above.

As regards claim 48, note the rejection of claims 18 and 34 above.

As regards claims 49 and 51, note the rejection of claims 8 and 34 above.

As regards claim 62, note the rejection of claims 18 and 49 above.

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18. Claims 35, 45, 50 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Dabroski and Smith as applied to claim 34 above, and further in view of Dow, Jr.

As regards claim 35 and 50, note the rejection of claims 4 and 34 and 49.

As regards claim 45, note the rejection of claims 15 and 34 above.

As regards claim 59, note the rejection of claims 15 and 49 above.

19. Claims 37, 38, 46, 47, 52, 53, 60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Dabroski and Smith as applied to claim 34 above, and further in view of Zaffaroni.

As regards claims 37, 38, 52 and 53, note the rejection of claims 6, 7, 34 and 49 above.

As regards claims 46, 47, 60 and 61, note the rejection of claims 16, 17, 38 and 39 above.

20. Claims 40 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Dabroski and Smith as applied to claim 34 above, and further in view of Gianpoulos.

As regards claims 40 and 54, note the rejection of claim 9, 34 and 39 above.

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21. Claims 42 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Dabroski and Smith as applied to claim 34 above, and further in view of Koch et al.

As regards claims 42 and 56, note the rejection of claims 11, 34 and 39 above.

22. Claims 44 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Dabroski and Smith as applied to claim 34 above, and further in view of Goldstein.

As regards claims 44 and 58, note the rejection of claims 14, 34 and 39 above.

Allowable Subject Matter

23. Claims 13, 28, 43 and 57 are is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

24. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is (571) 272-4796. The examiner can normally be reached on Mondays to Thursdays from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett, can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kim M. Lewis
Primary Examiner
Art Unit 3743

kml
January 24, 2005